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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,845	12/12/2003	Rodney M. Caldwell	M09697	1979

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EXAMINER

SMALLEY, JAMES N

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,845

Applicant(s)

CALDWELL, RODNEY M.

Examiner

James N. Smalley

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/12/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Griffin, Jr., et al. US 2,298,938.

Griffin '938 teaches a vented cap comprising a cap with a cylindrical side wall (15), internal thread, vent (17), cup member (18) with a radially extending flange (21) and fluid passage (22), and a filter (23).

Regarding claim 7, the cap of Griffin '938 is capable of being used to cover an oil reservoir. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 9, the filter could be used as a polishing pad. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

3. Claims 1, 3-10 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapsy US 3,961,724.

Kapsy '724 teaches a vented cap comprising a cap with a cylindrical side wall (12), internal thread, vent (21), cup member (26) with a radially extending flange (25) and fluid passage (33), and a filter (24).

Regarding claim 7, the cap of Kapsy '724 is capable of being used to cover an oil reservoir. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be

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employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 9, the filter could be used as a polishing pad. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 11-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapsy US 3,961,724 in view of Steiner US 4,884,716 and in view of Gregory US 5,197,620.

Regarding claims 2, 11, and 19, Kapsy '724 does not teach a slot in the inner surface of the cylindrical sidewall, and in the inner surface of the top portion. However, the reference does teach venting means through top vent hole (21).

Steiner '716 teaches a means for venting a cap, comprising radial grooves (36) and venting through the spaces between the cap threads.

Regarding the grooves (36), it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the grooves of Steiner '716 to the cap of Kapsy '724, and furthermore locate them on the inner surface of the cap top wall. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Furthermore, Gregory '620 teaches an alternative means for venting gas through container threads, by providing axial grooves through the threads.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Kapsy '724, providing axial grooves on the cap inner sidewall, as taught by the combined teachings of Steiner '716 and Gregory '620, motivated by the benefit of relocating the cap venting means.

Regarding claims 16 and 20, the cap of Kapsy '724 is capable of being used to cover an oil reservoir. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 17, Kapsy '724 does not teach a foam filter.

Steiner '716 teaches a foam filter (42). It is known that foam is an inexpensive and durable material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the filter of Kapsy '724, providing a foam filter, as taught by Steiner '716, motivated by the benefit of applying a filter formed of an inexpensive and durable material.

6. Claims 8, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin, Jr., et al. US 2,298,938 in view of Kapsy US 3,961,724.

Griffin '938 does not teach a seal member disposed between the cap top and the cup flange. However, Griffin '938 teaches in col. 2, lines 30-33, that the tight engagement compresses flange (21) and provides a seal. It would be obvious to provide a seal as a separate component.

Kapsy '724 teaches it is known to provide a seal between a cup flange and cap top. Providing a gasket as a separate component allows it to be replaced without having to replace the entire cup portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Griffin '938, providing the seal as a separate component, as taught by Kapsy '724, motivated by the benefit of allowing a user to replace the seal without having to replace the entire cup portion. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

7. Claims 2, 11-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin, Jr., et al. US 2,298,938 in view of Kapsy US 3,961,724 as applied above under 35 U.S.C. 103(a) to claims 1, 10 and 18, and further in view of Steiner US 4,884,716 and in view of Gregory US 5,197,620.

Regarding claims 2, 11, and 19, Griffin '938, as modified, does not teach a slot in the inner surface of the cylindrical sidewall, and in the inner surface of the top portion. However, the reference does teach venting means through top vent hole (17).

Steiner '716 teaches a means for venting a cap, comprising radial grooves (36) and venting through the spaces between the cap threads.

Regarding the grooves (36), it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the grooves of Steiner '716 to the cap of Griffin '938, and furthermore locate them on the inner surface of the cap top wall. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Furthermore, Gregory '620 teaches an alternative means for venting gas through container threads, by providing axial grooves through the threads.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Griffin '938, providing axial grooves on the cap inner sidewall, as taught by the combined teachings of Steiner '716 and Gregory '620, motivated by the benefit of relocating the cap venting means.

Regarding claims 16 and 20, the cap of Griffin '938 is capable of being used to cover an oil reservoir. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 17, Griffin '938 does not teach a foam filter.

Steiner '716 teaches a foam filter (42). It is known that foam is an inexpensive and durable material.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the filter of Griffin '938, providing a foam filter, as taught by Steiner '716, motivated by the benefit of applying a filter formed of an inexpensive and durable material.

### **Conclusion**


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:  
See attached PTO-892, citing various related references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns

  
NATHAN J. NEWHOUSE  
PRIMARY EXAMINER